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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,108	04/26/2001	Arthur Tauber	CECOM 5469	1631

7590 01/14/2003  
U.S. Army Communications-Electronics Command  
ATTN: AMSEL-LG-L (George B. Tereschuk, Esq.)  
Fort Monmouth, NJ 07703

EXAMINER

BOS, STEVEN J

ART UNIT	PAPER NUMBER
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1754

10

DATE MAILED: 01/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/845,108

Applicant(s)  
Tauber et al

Examiner  
Steven Bos

Art Unit  
1754



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Nov 25, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-79 is/are pending in the application.
- 4a) Of the above, claim(s) 5, 8, 11, 14, 17, 20, 23, 26, 29, 32, 35, 38, 41, 44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 7, 9, 10, 12, 13, 15, 16, 18, 19, 21, 22, 24, 25, 27, 28, 30, 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-79 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4,6,7,9,10,12,13,15,16,18,19,21,22,24,25,27,28,30,31,33,34,36,37,42,43,50 are rejected under 35 U.S.C. 103(a) as being unpatentable over the journal article by Fesenko, et al.

Fesenko teaches the instantly claimed compounds which would have dielectric characteristics since the stoichiometry of the taught compounds is the same as that instantly claimed and thus would function as a dielectric substrate.

Where the examiner has found a substantially similar product as in the applied prior art the burden of proof is shifted to the applicant to establish that their product is patentably distinct, In re Brown, 173 USPQ 685, In re Fessmann, 180 USPQ 324, In re Spada, 15 USPQ2d 1655, In re Fitzgerald, 205 USPQ 594, MPEP 2112 and In re Best, 195 USPQ 430.

Claims 1-4,6,7,18,19,24,25,33,34,39,40,42,43,50 are rejected under 35 U.S.C. 103(a) as being unpatentable over the journal article by Wittmann, et al.

Wittmann teaches the instantly claimed compounds which would have dielectric characteristics since the stoichiometry of the taught compounds is the same as that instantly claimed and thus would function as a dielectric substrate.

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Where the examiner has found a substantially similar product as in the applied prior art the burden of proof is shifted to the applicant to establish that their product is patentably distinct, In re Brown, 173 USPQ 685, In re Fessmann, 180 USPQ 324, In re Spada, 15 USPQ2d 1655, In re Fitzgerald, 205 USPQ 594, MPEP 2112 and In re Best, 195 USPQ 430.

Claims 1,2,30,31,50 are rejected under 35 U.S.C. 103(a) as being unpatentable over the journal article by Blasse.

Blasse teaches the instantly claimed compounds which would have dielectric characteristics since the stoichiometry of the taught compounds is the same as that instantly claimed and thus would function as a dielectric substrate.

Where the examiner has found a substantially similar product as in the applied prior art the burden of proof is shifted to the applicant to establish that their product is patentably distinct, In re Brown, 173 USPQ 685, In re Fessmann, 180 USPQ 324, In re Spada, 15 USPQ2d 1655, In re Fitzgerald, 205 USPQ 594, MPEP 2112, and In re Best, 195 USPQ 430.

Applicant's arguments filed November 25, 2002 have been fully considered but they are not persuasive.

Applicant states that the cited prior art does not teach or suggest the instantly claimed dielectric substrates or buffer layers.

However indications of the contemplated field of use in the preamble of a product claim is not a limitation to be considered in the question of patentability, In re Hack 114 USPQ 162. It is also noted that the form of a product is not a matter of invention, In re Rose 105 USPQ 237.

Applicant states that the instant dielectric substrates and buffer layers are not obvious because of the polarizability of the  $\text{Sb}^{5+}$  atom.

However it is not clear on the record that the prior art does not also have the same polarizability because they have the same stoichiometry. It is not possible for the examiner to determine that the cited prior art does not have the instantly claimed product characteristics including the instantly claimed polarizability. Where the claimed and prior art product(s) are identical or substantially identical, or are produced by identical or substantially identical process(es) the burden of proof is on applicant to establish that the prior art product(s) do not necessarily possess the characteristics of the instantly claimed product(s), see In re Best, 195 USPQ 430. It is noted that instant claims 1 and 50 do not even require said polarizability.

The decisions of Zurko III, Zurko IV and Rapoport are noted however they do not appear to be pertinent to the instant issue regarding product claims. The cited prior art above sufficiently teaches the instantly claimed stoichiometry of the instantly claimed compounds so that it still appears that the taught compounds would have the instantly claimed product characteristics, absent a showing to the contrary. It is noted that none of the Zurko and Rapoport decisions reversed or contradicted the product related case law cited above therefore this case is still applicable.

The above applies equally with regard to each argument of Fesenko and Wittmann and Blasse.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Bos whose telephone number is (703) 308-2537. The examiner is on the increased flexitime program schedule and can normally be reached between 8AM and 6PM Monday through Friday. The FAX No. for After Final amendments is 703-872-9311; for all others it is 703-872-9310. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read 'S. Bos', is positioned above the printed name.

Steven Bos  
Primary Examiner  
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